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JUL 31 1965
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

October Term, 1965
No. 413

SHELDON L. POLLACK and MAX E. ADAMS,
Petitioners,

vs.

COMMISSIONER OF PATENTS,
Respondent.

PETITION FOR WRIT OF CERTIORARI.

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To the Honorable Chief Justice of the Supreme Court of the United States and to the Honorable Associate Justices Thereof:

Your petitioners respectfully petition for a writ of certiorari directed to the United States Court of Appeals for the District of Columbia to bring up and to consider and reverse the judgment of that court and the District Court of Columbia in denying a patent to the petitioners for a novel and highly successful method of erecting a high strength grout filled metal reinforced brick wall, particularly in earthquake country, and to consider and define the meaning of a "*trial de novo*" and to consider and to hold that trying a patent case "de novo" the effect of the presumption of correctness of the decision of the Patent Office contrary to the intent of Congress in enacting Section 145 of Title 35 and is a denial of due process of law guaranteed by the Fifth Amendment to the Constitution of the United States.

Jurisdiction.

Jurisdiction is conferred by Title 28, Section 1254, U.S. Code.

The decision of the Court of Appeals was rendered April 8, 1965. This petition for certiorari is being filed within 90 days.

Opinion Below.

The decision of the United States District Court for the District of Columbia and the opinion of the United States Court of Appeals for the District of Columbia are attached hereto as Appendix A and Appendix B, respectively.

Statutes Involved.

Fifth Amendment, United States Constitution;

"No person shall be . . . deprived of life, liberty, or property, without due process of law . . ."

Sixth Amendment—Calif.

Amendment 6

In all criminal prosecutions, the accused shall enjoy the right to a speedy and public trial, by an impartial jury of the State and district wherein the crime shall have been committed, which district shall have been previously ascertained by law, and to be informed of the nature and cause of the accusation; to be confronted with the witnesses against him; to have compulsory process for obtaining witnesses in his favor, and to have the Assistance of Counsel for his defense.

Title 35, Section 145, U.S. Code:

"An applicant dissatisfied with the decision of the Board of Appeals may unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decisions, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant."

Questions Presented.

1. Whether the invention of a grout filled monolithic wall, encompassing uncoated brick, uncoated tie rods and uncoated supporting steel and answering a high need and highly useful *in earthquake country* is of such a novel and useful and needed character that it, together with its commercial success, in absence of commercial success of other competing or prior developed walls, entitles the inventor to a patent.

2. Whether commercial success of this invention and for commercial failure of prior art is a factor to be considered by the Court of Appeals as well as the trial court on whether the invention should receive a patent.

3. Whether the petitioner was denied due process of law guaranteed by the Fifth Amendment to the Con-

stitution of the United States when the Patent Office relied solely upon the presumption of the determination of the Patent Office without presenting any witnesses subject to examination and cross-examination.

4. Whether, under Title 35, Section 145, U.S.C., petitioners were entitled to a "trial *de novo*" in which all of the witnesses, including any witnesses who may have any facts in connection therewith from the Patent Office, were called.

5. Whether the denial of the right of cross-examination of the Patent Office witnesses and the denial of the right to be confronted by them and to cross-examine them is a denial of due process of law under the Fifth Amendment to the Constitution of the United States and of a trial on the merits as guaranteed by the Fifth, Sixth and Seventh Amendments to the Constitution of the United States.

6. Whether recognition of novelty and utility by cities and the State to gear their building code to include this new method of construction and use of walls reproduced thereby is evidence of patentability.

The Facts.

The invention claimed by the petitioners in their patent application relates to a monolithic earthquake resistant building wall and is set forth in the specifications and claims and drawings reproduced in the Joint Appendix, pages 123-136c. Only two claims are involved: Claims 17 and 18.[1] The Patent Office denied a patent.

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[1] "17. The method of erecting a high strength grout filled metal reinforced brick wall comprising the steps of: erecting vertical metal reinforcement members; placing a plurality of horizontal

Thereupon, petitioners sought a trial *de novo* in the District Court, as provided by Title 35, Section 145. U.S.C. The Patent Office did not produce any witnesses and none of their so-called experts or technicians were produced for examination or cross-examination. The petitioners produced as a witness Robert E. Franklin, a consulting structural engineer, qualified by Master of Science in Civil Engineering, his registration as a civil and structural engineer in California and elsewhere, and an engineering teacher at various universities.

Mr. Franklin testified that there had long been a need for a low-cost method of providing earthquake resistant structures (J. A. 64, 65). It was established that there were many areas of the United States in which earthquake stresses on building structures occurred. These areas stretched from Maine to California and Washing-

---

layers of pairs of bricks on top of one another to provide two parallel vertical brick walls so positioned that said metal reinforcement members are disposed approximately midway between the opposed parallel surfaces of said brick walls, each of said pairs of bricks being held in spaced parallel relationship to each other by metal connecting means having a strength greater than that of material of said bricks, and a cross section small in comparison to the length and height of said bricks; and thereafter filling the space between said walls and surrounding said metal connecting means and said vertical metal reinforcement members with grout thereby forming a unitary monolithic reinforced wall structure."

"18. A unitary monolithic wall construction comprising: a plurality of vertical metal reinforcement members; two vertical brick walls having opposed parallel surfaces including a plurality of horizontal layers of pairs of bricks located on top of one another and disposed approximately the same distance from and on opposite sides of said reinforcement members, each pair of said parallel bricks having metal connecting means to hold said bricks in spaced parallel relation to each other, said connecting means having a strength greater than that of the material of said bricks and a cross section small in comparison to the length and height of said bricks; and grout located in the space between the opposed parallel surfaces of said walls and surrounding said connecting means and said vertical metal reinforcement members."

ton (Exhibit 3, J. A. 178-D and Exhibit 4). The need for a low-cost earthquake type construction has existed throughout recorded history of construction and particularly in the West since the disastrous earthquakes in San Francisco of 1905, in Long Beach of 1933, and in Helena, Montana of 1935. It was undisputed that the Pollack and Adams wall met the qualifications for an earthquake resistant building wall and at low cost. It was expressly approved by numerous cities, including the city of Long Beach (Exhibit 7, J. A. 179, 183 and City of Los Angeles, Exhibit 8, J. A. 181), as a building wall. It is uncontradicted from the testimony of Mr. Franklin that the Pollack and Adams method produced an unusual and surprising result (J. A. 66, 86). The Pollack and Adams wall was established by the record before the trial court as a monolithic building wall "because the grout mix and the face shell units are firmly bonded together and because the grout and reinforcing steel is firmly bonded together, so that all the elements of the wall, whether the elements be large or small, must react on strain and stress together . . . so that the wall acts as a unit" (J. A. 68-72). Exhibits were offered showing numerous buildings constructed in accordance with the claims in plaintiffs' application (J. A. 82-85, 185-191, and Exhibits 12, 13, and 14). Mr. Franklin expressly testified and without contradiction that the Pollack and Adams method filled the need for a low-cost method of earthquake resistant construction (J. A. 85).

Mr. Franklin testified that a method known as the Hild method of construction differed in that the inside faces of the wall are covered with waterproofing materials to keep the weather out and the steel elements themselves have either been galvanized or painted with

red lead or some other materials to prevent corrosion. The space in between the two parallel brick walls is not filled with grout except in the foundation. Even the foundation is not monolithic because there is no bond between the grout and the wall because of the waterproofing membrane and no bond between the grout and the reinforcing steel because of the coating of corrosion resistant material. The foundation therefore does not act as a single unit but rather as three separate elements. [J.A. 91]

Considerable difficulty is encountered in attempting to construct a Hild wall. [J.A. 93] This is because extreme care must be used to align the vertical steel, the horizontal steel, and the horizontal crossed ties to place them in such close proximity such that they may be welded to produce a Vierendeel truss. Delay is further encountered in the construction of this wall since as each course is laid it is necessary to weld the cross-ties on the vertical steel members. An additional intermediate step called for by the said Hild patent is the waterproofing of the wall. [J.A. 93]

Mr. Franklin testified that the Hild method of construction is not now being used and further did not meet the requirements in California or elsewhere for an earthquake resistant wall. [J.A. 90]

A deposition was also produced by petitioners of the testimony of Thomas N. Jameson. [J.A. 184-195] This witness had personal experience as to the extensive industry acceptance of the petitioners' invention.

The petitioners also introduced 18 exhibits relating to their invention, which are reproduced in part in the Joint Appendix. Certain of these exhibits demonstrate

the dramatic industry recognition of the novelty and utility of the invention, by the change required in the Uniform Building Code to include and approve Pollack and Adams method of construction and the wall produced thereby. [J.A. 75-76, Ex. 9, J.A. 182a] Likewise, the building Codes of both the City of Los Angeles, California, and the City of Long Beach, California, were amended to include and approve these new methods of construction. [J.A. 73-75, 179, Ex. 7, J.A. 181, Ex. 8] The Pollack and Adams invention is also approved for schools by the State Division of Architecture in California and meets the high safety requirements thereof for earthquake resistant construction. [J.A. 73]

None of this testimony was contradicted or rebutted. The defendant relied on prior patents referred to as Hild, Simms and Betzler and the presumption arising from the decisions of the Patent Office.

Reasons for Granting the Writ.

This case raises important questions of constitutional and statutory law involving trials and determinations of patent cases. It involves the construction of Congressional meaning of Title 35, Section 145, U.S. Code, as to a *"trial de novo,"* and when and how a *presumption* of Department of Patents action is overcome.

The petitioners have developed a highly commercially successful grout filled monolithic wall needed and used in earthquake country, particularly California. The Patent Office, which turned down a patent, did not deny either the novelty of the device nor the success commercially of the invention, nor did the trial judge

deny this novelty, usefulness and commercial success. In fact he stated, in refusing to order a patent, that:

> "They have made a remarkable wall. But regardless of how the Court may feel the Court's function is merely this:
>
> "To determine whether or not in view of the evidence here the strong presumption attached to the experts of the Patent Office has been overcome.
>
> "I find it has not been overcome. I find for the defendant and against the plaintiffs."

The trial judge rested on the *presumption* of the action of the Patent Office in rejecting the patent without producing any of the witnesses of the Patent Office to appear and testify or submit themselves to cross-examination and without holding that in a trial *de novo* all of the witness must be produced.

We respectfully contend that such procedure inherently and as construed and applied in this case violates the due process clause of the Fifth Amendment to the Constitution of the United States and is in conflict with recent decisions by this Court holding that the right of confrontation is a right guaranteed by the due process clause of the Constitution of the United States. Further, that the right to a hearing encompasses the right to produce witnesses who can be examined and cross-examined.

We think this is the meaning of the provisions of Title 35, Section 145, and that it has not been construed by this Honorable Court but should be so construed.

In the Legislative History, U.S. Code Congressional & Administrative News for 1952, Vol. 2, Page

2400, in discussing the amendment to the patent law in which Section 145 of Title 35 became a part, it is stated in Senate Report 1979 and House Report 1923 as follows:

> "The next chapter relates to the review of Patent Office decisions.
>
> "The act of 1836 provided, for the first time, for the refusal of patents by officials known as examiners. The legislature was jealous of the rights of the public and provided adequate means of reviewing the action of the Patent Office. In fact, there are now two types of review. The applicant may appeal to a court of appeals especially provided, or he may file suit in the district court against the Commissioner to have his rights adjudicated by the court."

We respectfully submit that this adjudication *de novo* means the production of witnesses and not the mere reliance on action already taken by the Patent Office, and this Court should so hold.

A presumption loses its validity when evidence is produced to overcome that presumption.

Dresser Industries, Inc. v. Smith-Blair, Inc. (C.A. Cal. 1963), 322 F. 2d 878;

Stradar v. Watson, 244 F. 2d 737.

While the historical references to Congress do not set forth the nature of a trial *de novo,* the language of the statute says that the court may adjudicate that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals *as the facts in*

the case may appear. Congress has not, in this or any other section, stated that the facts are determined from a presumption, nor has Congress declared that the actions of the Patent Office have a presumption of validity. Had Congress intended such a presumption to prevail over testimony, it would have done so as it has done in many cases, particularly narcotic cases.

The absence of any such Congressional declaration of the presumption is proof that no such presumption was intended to take place of a trial *de novo* under the well established doctrine of *inclusio unius exclusio alterius*.

In the case of *Tietig v. Ladd*, 228 F. Supp. 637, at 639, the Court said:

> "Initially, it should be stated that this Court is aware of the presumption of correctness that is attached to the decisions of the Patent Office. . . .
>
> "Nevertheless, this is a trial de novo, and if the plaintiffs have shown the Board of Appeals' decision is clearly erroneous or lacks a rational basis, it must find for the plaintiffs.
>
> "As evidence accumulated at trial, it became clear that plaintiffs' method of feeding alloys into a ladle by means of a vibratory pan was indeed a 'new and useful process' within 35 U.S.C. § 101 since no record existed of it ever having been done before."

We paraphrase our case to show that the method of erecting a high strength grout filled metal reinforced brick wall, comprised of the steps of erecting vertical metal reinforcement members; placing a plurality of horizontal layers of pairs of bricks on top of one another

to provide two parallel vertical brick walls so positioned that said metal reinforcement members are disposed approximately midway between the opposed parallel surfaces of said brick walls, each of said pairs of bricks being held in spaced parallel relationship to each other by metal connecting means, said metal connecting means having a strength greater than that of the material of said bricks, and a cross section small in comparison to the length and height of said bricks; and thereafter filling the space between said walls and surrounding said metal connecting means and said vertical metal reinforcement members with grout, thereby forming a unitary monolithic reinforced wall structure. A unitary monolithic wall construction comprising; a plurality of vertical metal reinforcement members; two vertical brick walls having opposed parallel surfaces including a plurality of horizontal layers of pairs of bricks located on top of one another and disposed approximately the same distance from and on opposite sides of said reinforcement members, each pair of said parallel bricks having metal connecting means to hold said bricks in spaced parallel relation to each other, said connecting means having a strength greater than that of the material of said bricks and a cross section small in comparison to the length and height of said bricks; and grout located in the space between the opposed parallel surfaces of said walls and surrounding said connecting means and said vertical metal reinforcement members; and used for earthquake resistant construction and for the first time included in the specifications by cities and a State for their walls. This shows that it is indeed a new and useful process, within 35 U.S.C. Section 101, since there is no record of it ever having been done this way before.

Continuing on with *Tietig v. Ladd, supra,* the Court said:

> "This narrowed the issue to whether, under the language of 35 U.S.C. § 103, 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art * * *.'"

This identical question was raised in the Patent Office in connection with patents known as the Hild, Simms and Betzler patents. The building unit disclosed in Hild is a pair of bricks which are coated with a water and moisture proofing material and which are joined together by bars which are galvanized or coated with a material to prevent corrosion. No grout is placed therein and, in fact, grouting is contrary to the teaching of the said Hild patent which, as respects building walls, expressly teaches a hollow wall. Moreover, as established by the undisputed testimony of the expert called by petitioners, this type of wall precluded bonding and a monolithic structure is not created thereby.

The Betzler patent merely demonstrated that it was old in the art to fill certain hollow walls with concrete. No contention was made by the Patent Office that there was anything in Betzler suggesting that it should be combined with Hild or that a solid wall produced by Betzler, filled with concrete would be monolithic. The undisputed testimony was that a wall produced in accordance with the Betzler patent would be prohibited by the local building ordinances and that it would not meet the building requirements for Washington, D.C. [J.A. 97]:

The other reference was to the Simms patent, and the testimony also was that this did not create monolithic walls because no concrete is poured around the vertical reinforcements. Since there is no bonding between the steel and brick units, each structural member acts as a separate unit.

The present type of wall has met a need for a low cost method differing from any of the other three, none of which was commercially successful. The petitioners' invention has been and is highly successful, especially in earthquake country such as Long Beach, Los Angeles and San Francisco, California, and in Montana.

In *Tietig v. Ladd, supra,* at page 640, the Court said:

> "The question of 'obviousness' has been a continuing source of discussion among the Courts, and is acknowledged by the writers to have no rigid definition. Certain factors are traditionally been influential, however, in determining in particular instances where a given difference between what was known and what was done would have been 'obvious' at the time.
>
> "One of these factors, that when present weighs heavily in favor of patentability, is the satisfaction of a long felt want in the industry to which the invention applies. Kelley et al. v. Coe, 69 App. D.C. 202, 99 L.Ed. 435, and Kaakinen et al. v. The Peelers Company, 301 F.2d 170."

As in the *Tietig* case, the petitioners in this case showed by undisputed evidence that the industry needed this earthquake type of construction since the disastrous earthquakes in San Francisco in 1905 and in Long Beach in 1933 and in Helena, Montana in 1935. So far

as is known, this invention is the only novel and useful invention and commercially successful one that meets this important factor of filling a long felt need.

Commercial success is a factor of positive value in determining whether a patent actually involves novelty and invention.

Hutsler Bros. Co. v. Sales Affiliates, 164 F. 2d 260;

Eastern Venetion Blind Co. v. Acme Steel Co., 188 F. 2d 247 (cert. den. 342 U.S. 824);

Ingersoll Milling Machine Co. v. General Motors, 110 F. Supp. 12 (Aff. 207 F. 2d 42).

In *Kelley v. Coe,* 99 F. 2d 435, the Court said, at page 442, quoting from *Wach v. Coe,* 64 App. D.C. 235, 236, 237, 77 F. 2d 113, 114, 115:

> " 'Where, as here, the new device is also useful and marks a distinct and novel advance in the art, it should receive patent protection. For almost 25 years, as we have seen, patents have been granted in this art on devices that proved to be practically worthless, and yet appellant has been refused a patent on his successful device because the Patent Office has found that, by taking this and that from the unsuccessful patents, the result achieved by appellant could have been accomplished.'
>
> "The Commissioner's argument in the present case comes down to the same result. He contends that anyone skilled in the art could have taken this and that from the various patents and, putting them together, could have devised the Kelley method. But the fact remains that, in the face of a crying need for a new process or method in the in-

dustry, not one of the best engineers in the world, with their attention especially directed to the subject for approximately thirty years, was able to see what Kelley saw, or to produce the result which he produced. The evidence in support of appellants' application establishes beyond doubt their right to the issuance of a patent."

Likewise, in the case at bar, there has been a crying need for a wall that would be protective against earthquakes. The Patent Office took this and that from unsuccessful patents of Hild, Simms and Betzler and yet have refused a patent on the successful device of Pollack and Adams which meets a crying need in earthquake country.

As was said in *Kelley v. Coe,* 99 F. 2d at 440:

"The difference between it and the prior art may not be great in a physical sense, but slight as it may seem to be it was sufficient to achieve success where success had never before been achieved. It was not merely one step in a development process, but was the one step from failure to success. As was said in The Barbed Wire Patent, 143 U.S. 275, 282-283, 12 S.Ct. 443, 446, 36 L.Ed. 154:

" 'Under such circumstances courts have not been reluctant to sustain a patent to the man who has taken the final step which has turned a failure into a success. In the law of patents, it is the last step that wins. * * * There are many instances in the reported decisions of this court where a monopoly has been sustained in favor of the last of a series of inventors, all of whom were groping to attain a certain result, which only the last one of the number seemed able to grasp.' "

This Court has not heretofore construed the meaning of a trial *de novo* as set forth in Title 35, Section 145. We respectfully contend that the language of a trial *de novo* means producing all of the witnesses available on the subject anew. To follow the practice in this case would be to hold that a trial *de novo* merely meant that the petitioner should bring in his witnesses and not the Patent Office or the opponents to the patent. This is not the meaning of a trial *de novo.*

A *de novo* trial in an appellate court is a trial had as if no action whatever had been instituted below.

Carcher v. Gelden, 32 Atl. 223, 8 Hous. 163;

Archer v. High, 9 So. 2d 647, 648, 193 Miss. 361;

Lone Star Gas Co. v. State, 153 S.W. 2d 681, 692;

Reck v. Reck, 46 N.E. 2d 429, 430.

"*De novo*" means fresh or anew or for a second time, and *de novo* trial in a reviewing court is trial had as if no action whatever had been instituted in the court below.

In re Hayes, 135 S.E. 2d 645, 649;

Wilson v. Morris, 369 S.W. 2d 402;

Foster v. Carson School District No. 301, 63 Wash. 2d 29, 385 P.2d 367.

In *Southern Canal Co. v. State Board of Water Engineers,* 159 Tex. 227, 318 S.W. 2d 619, 622, the court held that the meaning of a *de novo* trial, where that term is used to describe a retrial of a matter of controversy theretofore tried by another tribunal, is the nullification of the judgment or order of the first tri-

bunal and retrial of the issues on which judgment or order was founded and when jurisdiction of the second tribunal attaches the order of the first tribunal is not merely suspended but is nullified.

This is the general meaning and understanding of "*de novo*" and therefore the action or order of the Patent Office denying a patent is not merely suspended, but nullified under the terms of the statute and there is no presumption of regularity of a nullified order or determination.

See also:

In re Pines Estate, 16 Ill. App. 2d 574, 149 N.E. 2d 787;

In re Betts' Estate, 2 Ill. App. 2d 453, 119 N.E. 2d 801.

In *Hiner v. Wenger,* 91 S.E. 2d 637, 639, 197 Va. 869, the court held that where the statute directed a trial *de novo* on appeal that the court was required to hear or try the case on its merits, from beginning to end, as if no trial or hearing had been held by the Board and without any presumption in favor of the Board's decision.

In *Hiner v. Wenger, supra,* in discussing the meaning of the language that the court "*shall hear the matter de novo*", this means that the court must hear or try the case on the merits, from beginning to end, as if no trial or hearing had been held by the Board and without any presumption in favor of the Board's decision. (30 C.J.S.)

We submit, therefore, that the meaning of Congress was the ordinary, legal meaning of the words "*de novo*" as defined in many cases, and did not mean that

the decision could rest on the presumption of validity attaching to the Patent Office adjudications but that that adjudication must be set aside and it must be heard *de novo*. This Court should grant a hearing to determine the constitutional issue of the validity of the presumption as denying due process of law guaranteed by the Fifth Amendment.

The presumption of validity of the Commissioner's determination denied to the petitioners the right to cross-examine the experts upon which the presumption is based. A proceeding which denies confrontation of witnesses and an opportunity to cross-examine violates the fundamental principles of due process of law.

Furthermore, such a proceeding is incongruous, partial, arbitrary and capricious. It denied to the court the opportunity to weigh all of the evidence and it denied to the court the right to see and hear the witnesses before it acted and to give such weight to the witnesses as the court determined. In *Powell v. Alabama,* 287 U.S. 45, the famous words of Webster are quoted, that "the law of the land" is intended "a law which hears before it condemns."

Title 35, Section 145, U.S. Code, makes no provision for the admission of any Patent Office records and makes no provision as to the effect of the records in the Patent Office. It makes no provision for the production of the experts of the Patent Office or the examiners of the Patent Office or examination or cross-examination. Thus the proceedings in the Patent Office, which are *ex parte* or *in camera,* are taken as determinative of the issues without the right or opportunity of cross-examination.

In *Pointer v. Texas,* 380 U.S. 400, 13 L. ed. 923, this Court points out that the Sixth Amendment affords an accused the right to be confronted by the witnesses against him as an essential to fair trial and is made obligatory on the States under the Fourteenth Amendment. This right of confrontation and cross-examination is as equally important in patent cases. A man's whole lifetime effort may be obliterated by the failure to produce the witnesses and be confronted by those purported examiners or experts who ruled against him.

As stated in *Pointer v. Texas, supra:*

> "And probably no one, certainly no one experienced in the trial of lawsuits, would deny the value of cross-examination in exposing falsehood and bringing out the truth in the trial of a criminal case. See, *e.g.* 5 Wigmore, Evidence § 1367 (3d ed. 1940). The fact that this right appears in the Sixth Amendment of our Bill of Rights reflects the belief of the Framers of those liberties and safeguards that confrontation was a fundamental right essential to a fair trial in a criminal prosecution."

We say in any trial the right of confrontation is one of the fundamental guarantees of fair trial.

Quoting again, Mr. Justice Stone, writing for the Supreme Court in *Alford v. U.S.,* 282 U.S. 687, declared that "The right of cross-examination is 'one of the safeguards essential to a fair trial' ". What is said in *Pointer v. Texas, supra,* and in *Douglas v. Alabama,* 380 U.S. 415, 13 L.ed. 2d 934, is equally applicable in patent cases.

In *Douglas v. Alabama, supra,* this court said, in headnote 3:

> "The primary object of the confrontation clause of the Sixth Amendment is to prevent depositions or *ex parte* affidavits being used against an accused in lieu of a personal examination and cross-examination of the witnesses."

But there is no cross-examination in the proceedings in the Patent Office, nor are the papers produced, nor does the trial judge in a patent case have an opportunity for appearance testimony so that he, the judge, might look at the witness and judge by his demeanor on the stand and the manner in which he gives his testimony whether he is worthy of belief (156 U.S. 237, 242, 243, 39 L.ed. 409, 411). Nor is the so-called examiner or expert in the Patent Office subject to examination as to a foundation as to his ability or knowledge or whether he has accurately applied it, nor could the court as, within reason and certainty, that the Patent Office would have decided the case as it did after such witnesses had been cross-examined.

In *United States v. Gainey,* 380 U.S. 63, 13 L.ed. 658, this Court upheld a statutory presumption regarding the presence of a person at a still and a full discussion is contained therein by Mr. Justice Black upon statutory presumptions.

But in the instant case there is no statutory presumption. Congress omitted passing such a presumption and therefore, it must be assumed that the trial *de novo* meant exactly what it said.

A presumption has been defined by statute as "A deduction which the law expressly directs to be made from particular facts."

Wigmore says:

"It must be kept in mind that the peculiar effect of a presumption 'of law' (that is, the real presumption) is merely to invoke a rule of law compelling the jury to reach the conclusion *in the absence of evidence to the contrary* from the opponent. If the opponent *does* offer evidence to the contrary (sufficient to satisfy the judge's requirement of some evidence), the presumption disappears as a rule of law, and the case is in the jury's hands free from any rule." Wigmore, Evidence, § 2491 (3d ed.)

In *Smith v. Asbell,* 2 Strobh. 141, 147:

"Presumptions . . . are artificial rules which have a legal effect independent of any belief, and stand in the place of proof *until the contrary be shown.*"

And quoting *Mockowik v. Kansas City, St. J. & C.B. Co.,* 196 Mo. 550, 571, 94 S.W. 256:

" 'Presumptions,' as happily stated by a scholarly counselor, 'ore tenus,' in another case, 'may be looked on as the bats of the law, flitting in the twilight but disappearing in the sunshine of actual facts.' "

In *Kath v. Kath,* 238 Minn. 120, 55 N.W. 2d 691, 693, the court said:

"A presumption, however, is merely a procedural device and dictates a decision only where there is an entire lack of competent evidence to the contrary and the very moment substantial countervailing evidence appears from any source it ceases to have any function and vanishes completely from the cause as if it had never existed."

In *French v. Edwards,* 80 U.S. 506, 13 Wall. 506, 20 L. Ed. 702, this Court said:

> "Presumptions are indulged to supply the place of that which is not apparent and not to give a new character to that which is seen to be defective."

Where, as here, then, there was positive evidence regarding the invention, its great usefulness, its answer to an important need in earthquake country, its commercial success, testified to by an expert witness and by a deposition of another expert, it is respectfully submitted that no presumption of the Patent Office remained and that the petitioners are entitled to their patent.

This case raises an important question of constitutional and statutory law with reference to patent cases and it is important that a hearing be granted and the judgments and orders below reversed and an order made by this Court, directing the Commissioner of Patents to grant petitioners a patent.

Respectfully submitted,

MORRIS LAVINE,
Attorney for Petitioners.

APPENDIX A.

Decision by the United States District Court for the District of Columbia.

The Court: Well, I have listened with great interest to the testimony of the witness on the stand and, of course, in this type of a *de novo* bill the testimony and all [98] of the evidence in it must show clearly that the experts in the Patent Office were wrong.

I haven't heard one word in the record before me that it would not be obvious to one skilled in the art knowing the prior art as it is to do exactly what these men have done.

They have made a remarkable wall. But regardless of how the Court may feel the Court's function is merely this:

To determine whether or not in view of the evidence here the strong presumption attached to the experts of the Patent Office has been overcome.

I find it has not been overcome. I find for the defendant and against the plaintiffs.

The defendant will present proposed findings of fact, conclusions of law and an order.

Court now stands adjourned until tomorrow morning at 10:00 o'clock.

The Deputy Marshal: This Honorable Court stands adjourned until 10:00 o'clock tomorrow morning.

(Whereupon, at 2:40 p.m. the trial of Civil Action No. 503-63, Pollack & Adams v. Ladd, Comm'r of Patents, was concluded.)

APPENDIX B.

United States Court of Appeals for the District of Columbia Circuit. No. 18801.

Sheldon L. Pollack, et al., Appellants, v. David L. Ladd, Commissioner of Patents, Appellee.

Appeal from the United States District Court for the District of Columbia.

Decided April 8, 1965

Mr. Elwood S. Kendrick, of the bar of the Supreme Court of California, *pro hac vice,* by special leave of court, with whom *Messrs. E. H. Mosher* and *A. Donald Stolzy,* were on the brief, for appellants.

Mr. George C. Roeming, Attorney, United States Patent Office, with whom *Mr. Clarence W. Moore,* Solicitor, United States Patent Office, was on the brief, for appellee.

Before Wilbur K. Miller, *Senior Circuit Judge,* and Danaher and McGowan, *Circuit Judges.*

Danaher, *Circuit Judge:* After adverse rulings by the tribunals of the Patent Office, the appellants here asked the District Court to authorize the Commissioner to issue a patent on their application, serial No. 825,124. Particularly involved were the appellants' Claim 17 respecting a method of erection of a high-strength grout-filled metal-reinforced brick wall and Claim 18 describing a relatively inexpensive wall constructed in accordance with the method of Claim 17. After the *de novo* trial authorized by 35 U.S.C. § 145 (1958), the District Judge rendered an opinion pursuant to which judgment was entered for the Commissioner.

The experienced and able trial judge concluded that each of the claims at issue was directly readable upon prior art. Our examination of the entire record has persuaded us that we are bound to affirm.

There is no question that the appellants taught an improved method of erecting a highly useful grout-filled monolithic building wall. The results in actual use were seen to be excellent, indeed the evidence showed a high degree of commercial success. Important though such factors may be in a close case, of themselves they do not establish patentability. The trial judge reasonably could have concluded that there simply was an inadequate showing of invention.

We are bound to affirm.[1]

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[1]Standard Oil Development Co. v. Marzall, 86 U.S.App.D.C. 210, 214, 181 F.2d 280, 284 (1950); cf. L-O-F Glass Fibers Company v. Watson, 97 U.S.App.D.C. 69, 76, 228 F.2d 40, 47 (1955).

In the Supreme Court of the United States

OCTOBER TERM, 1965

No. 413

SHELDON L. POLLACK and MAX E. ADAMS,
PETITIONERS

v.

COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

BRIEF FOR THE COMMISSIONER OF PATENTS IN OPPOSITION

OPINIONS BELOW

The opinion of the district court (J.A. 36-43)[1] is reported at 229 F. Supp. 405.[2] The opinion of the

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[1] "J.A." refers to the Joint Appendix in the court of appeals.

[2] The brief oral opinion of the district court, set forth in Appendix A to the petition, was supplemented by a written opinion, referred to in the text.

court of appeals (Pet. App. 2-3) is reported at 346 F. 2d 799.

JURISDICTION

The judgment of the court of appeals was entered on April 8, 1965. The time for filing a petition for a writ of certiorari was extended on July 1, 1965, by order of Mr. Justice Goldberg to and including August 1, 1965. The petition for a writ of certiorari was filed on July 31, 1965. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

QUESTIONS PRESENTED

1. Whether the court of appeals erred in sustaining the district court's finding that petitioners' patent application did not exhibit a sufficient advance over the prior art to require issuance of a patent.

2. Whether, in a suit under 35 U.S.C. 145 to review the Patent Office's denial of a patent application, it is proper for the district court to accord presumptive validity to the decision of the Patent Office.

STATUTE INVOLVED

35 U.S.C. 145 provides in relevant part as follows:

> An applicant dissatisfied with the decision of the Board of Appeals may unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia * * *. The court may adjudge that such applicant is

entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. * * *

STATEMENT

In this action under 35 U.S.C. 145, petitioners sought review of the decision of the Patent Office denying their application for a patent relating to a reinforced masonry wall. Both the Patent Office Examiner (J.A. 161-71) and the Patent Office Board of Appeals (J.A. 172-8) had held petitioners' claims unpatentable on the ground that, in view of the prior art, the substance of the claims would be obvious to any person having ordinary skill in the art.[3]

Petitioners' application (J.A. 123-136C) disclosed a masonry wall built of units consisting of two parallel bricks joined by two metal rods having their ends embedded in the bricks. These units are stacked about previously erected reinforcing steel (J.A. 136A, Fig. 2). The space between the two brick walls is then filled with grout (a type of mortar),[4] which embeds the

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[3] See 35 U.S.C. 103: "A patent may not be obtained * * * if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. * * * *"

[4] "Grout" is defined as a "thin mortar fluid enough to be poured and used for filling in spaces (as the joints of masonry,

reinforcing steel (J.A. 136C, Fig. 5) and makes the wall monolithic.

Petitioners' application admitted the existence of prior art for making reinforced masonry walls under which "the bricks are laid separately on each side of reinforcing steel which is spaced therebetween. The grout is poured between the bricks to embed the reinforcing steel and to fill the space" (J.A. 124). The application states, however, that some building codes prohibited the pouring of grout in the prior art wall to a height of more than one brick at any one time. The application explained that, where there is nothing to hold the bricks together, the grout pressure will tend to push the bricks apart if the grout level is too high (J.A. 125). Petitioners' method makes it possible under these building codes to pour grout for many levels of brick at one time, since the metal rods embedded in the brick hold the two walls together (J.A. 129).

Investigation of the prior art revealed three prior patents for reinforced masonry walls in which two parallel brick walls are joined by rods or other connecting elements, the space between the walls being either left hollow or filled with grout—the Hild patent (J.A. 195J, 195K), the Betzler patent (J.A. 195D), and the Simms patent (J.A. 195L). There was evidence that petitioners' wall had achieved considerable commercial success and that the walls disclosed in the prior patents had not (J.A. 72-79, 80-87, 90, 97, 100, 155-56, 179-182G, 185-194).

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brickwork * * *)." Webster's *Third New International Dictionary.*

The district court held that petitioners had not overcome the "presumption of validity attaching to Patent Office adjudications" (J.A. 43). The court relied primarily on the prior art disclosed in the Hild patent (J.A. 42):

> Utilizing spaced two-brick units to build high walls on either side of vertical reinforcement members is clearly shown by Hild * * *. Pouring grout between the sides of spaced brick walls was admitted to be conventional * * *. Since both of these teachings were quite common in the art at the time of the invention, it does not appear to the Court that to combine them would have been more than an obvious expedient within the province of mechanical skill.[5]

As to the evidence of commercial success, the court stated that "[s]uch evidence must be considered immaterial * * * when invention is lacking" (J.A. 42).

The court of appeals affirmed on the basis of its "examination of the entire record" (Pet. App. 3). Conceding that petitioners "taught an improved method" and that "the evidence showed a high degree of commercial success," it stated (Pet. App. 3):

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[5] The district court held alternatively that "each of the claims is directly readable on the grout-filled foundation wall embodiment of Hild. That embodiment shows a monolithic wall construction made up of basic two brick units identical to plaintiffs' which are stacked on either side of vertical reinforcing members. After the bricks are stacked three or more layers high, the space between them is filled with grout. * * * [I]t seems to the Court that the solid foundation wall of the Hild patent is in all essential respects identical to the subject matter of plaintiffs' claims" (J.A. 41).

Important though such factors may be in a close case, of themselves they do not establish patentability. The trial judge reasonably could have concluded that there simply was an inadequate showing of invention.

ARGUMENT

1. Two administrative tribunals and two courts have held that the prior art precludes issuance of a patent to petitioners. The correctness of this decision cannot seriously be disputed. Petitioners' only contention with respect to the Hild patent—the principal item of the prior art—rests on a factual error, pointed out by the district court, as to the scope of the Hild patent.[6] Petitioners' failure to show a patentable advance over the prior art cannot be remedied by evidence of commercial success: "commercial success without invention will not make patentability." *A. & P. Tea Co.* v. *Supermarket Corp.*, 340 U.S. 147, 153.

2. The decision of this Court in *Morgan* v. *Daniels*, 153 U.S. 120, required the courts below to accord a presumption of validity to the Patent Office decision.

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[6] The district court stated (J.A. 42):

> The plaintiffs have contended that since the interior of Hild's *hollow* wall embodiment is coated to prevent corrosion, a person skilled in the art would not be taught to fill it with grout. This contention is effectively rebutted by the presence, in the very same disclosure, of a similar but non-coated *solid* wall embodiment which *is* filled with grout. It is further rebutted, of course, by the secondary references which show that to fill spaced brick walls with grout is common in the art." (Emphasis in original.)

Compare Pet. 13.

In that case, decided under Rev. Stat. 4915, the predecessor to 35 U.S.C. 145,[7] this Court held that the decision of the Patent Office must be accepted as controlling "unless the contrary is established by testimony which in character and amount carries thorough conviction." 153 U.S. at 125. This holding has been consistently followed. *E.g.*, *Gold* v. *Newton*, 254 Fed. 824, 827-828 (C.A. 2), certiorari denied, 249 U.S. 608; *Fletcher* v. *Watson*, 204 F. 2d 68, 69 (C.A.D.C.); *Abbott* v. *Coe*, 109 F. 2d 449, 451 (C.A.D.C.). The presumption has been held inapplicable only where the trial *de novo* in the district court reveals facts that were not before the Patent Office. *Stradar* v. *Watson*, 244 F. 2d 737, 739 (C.A.D.C.); cf. *Dresser Industries* v. *Smith-Blair, Inc.*, 322 F. 2d 878, 888 (C.A. 9). Here the full factual situation was disclosed in the evidence before the Patent Office, which included evidence of the commercial success of petitioners' wall—the fact on which petitioners principally relied in the district court (J.A. 155-56, 166, 177). There was no additional evidence before the district court requiring rejection of the administrative finding of no patentable advance over prior art.

Petitioners' complaint that they were denied the right of cross examination has no merit. The district court did not rely on any extra-record evidence; it simply held that petitioners had failed to discharge

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[7] While there are many differences in language between Rev. Stat. 4915 and 35 U.S.C. 145, the language that is crucial here—requiring the court reviewing the Patent Office decision to decide "as the facts in the case may appear"—is identical.

their burden of proving the administrative decision wrong.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

THURGOOD MARSHALL,
Solicitor General.

JOHN W. DOUGLAS,
Assistant Attorney General.

SHERMAN L. COHN,
ROBERT V. ZENER,
Attorneys.

SEPTEMBER 1965.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 413

SHELDON L. POLLACK AND MAX E. ADAMS,

Petitioners,

vs.

COMMISSIONER OF PATENTS,

Respondent.

REPLY TO OPPOSITION OF GOVERNMENT TO PETITION FOR WRIT OF CERTIORARI

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IN THE

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REPLY TO OPPOSITION OF GOVERNMENT TO PETITION FOR WRIT OF CERTIORARI

Come now Sheldon L. Pollack and Max E. Adams and reply to the opposition of the government to their petition for writ of certiorari as follows:

The government has abbreviated our questions incorrectly and reduced them to two. It has therefore not answered them. It has not fully set forth the questions we have specifically raised, which are of great importance not only in the patent world but in the construction of Title 35, Section 145(c), U.S. Codes, and particularly the words "trial de novo", not contained in Section 4915 of U.S. Codes.

The question here is this: Not only did the District Court err in holding that the case was governed by the

"presumption of validity attaching to the Patent Office adjudications" (R. 43), but the Circuit Court erred also in following the holding of the District Court that there had actually been "a trial de novo" where the trial "de novo" had, in fact, adopted "the presumption of validity attaching to the Patent Office adjudications" as grounds for its judgment.

We respectfully submit that Congress did not intend the presumption to take the place of evidence submitted by the Patent Office and did not intend to prevent confrontation of witnesses and prevent its examiners or technicians from being examined and cross-examined, from which testimony the court could judge whether the hidden and unknown examiners, reportedly working on small salaries, had made a correct determination. It is submitted that Congress meant a trial "de novo" to mean exactly what the words mean, namely, a *whole new trial,* with witnesses produced for the court to hear and examine, and the parties to have the right to examine and cross-examine.

The respondent cited Revised Statute 4915 and *Morgan v. Daniels,* 153 U.S. 120, 14 S.Ct. 772, 38 L.ed. 657, an 1894 case. However, Section 4915, Revised Statutes, did not contain the words "trial de novo" which have well established legal meaning and which mean a complete new trial, without presumptions, and in which the presumptions disappear when testimony is offered.

Morgan v. Daniels also is distinguishable by the fact that in that case unlike the present one the Patent Office had granted a patent and it was an *interference* case wherein Fred H. Daniels claimed to be the original, sole and first inventor of an improvement in machines for coiling wires or wire rods. It appears in that case that conflicting views were reached by different examiners

as well as by the examiners in chief and by the Commissioner of Patents, who reversed the judgment of the examiners in chief. That case was "submitted without any additional testimony to the Circuit Court".

In the case at bar, not only was testimony offered by the petitioner, but it was unrebutted by the Patent Office and the Patent Office did not submit its technicians for examination and cross-examination, a basic requirement of due process of law guaranteed by the Fifth Amendment U. S. Constitution. We respectfully submit that in amending and revising Statute 4915 into 35 U.S. Codes Sections 145 and 146, Congress had intended an entirely new trial "de novo".

35 U.S. Codes Section 145 makes no provision for the admission of any Patent Office record and makes no provision as to the effect of the record in the Patent Office. On the contrary, it provides that the court shall make its judgment "as the facts *in the case* may appear." Thus, to give the same presumptive evidentiary effect in a Section 145 proceeding as in a Section 146 proceeding, despite the absence of any similar foundation as to the Patent Office record, is to disregard the critical distinguishable features of a determination in the Patent Office in an ex parte hearing and a determination after an adversary proceeding.

It is especially incongruous, arbitrary and unreasonable to apply such a rule where *new* evidence is presented in the trial de novo. As noted in *Standard Oil Development Co. v. Marzall*, 86 App. D.C. 210, 181 F.2d 280:

> "We cannot in reason say with certainty that the Patent Office would have decided as it did had this additional evidence been before it. The trial in the District Court was de novo, as contemplated by re-

vised statute, 35 U.S.C. Section 63 (1946), 35 U.S.C.A. section 63. While ordinarily the record in the court will no doubt be quite similar to that in the Patent Office proceedings, see Globe Union, Inc. v. Chicago Telephone Supply Co., 7th Cir. 1939, 103 F.2d 722, 727, it need not be the same and it was not in this case."

Thus, for these reasons, the Circuit Court said:

"In so deciding, we do not give to the decision of the Patent Office the weight to which it would be entitled if its rejection of the claims had been made on the same facts as were before the District Court."

The standard of *Morgan v. Daniels, supra,* an adversary proceeding, should not be and is not applicable to an ex parte determination by the Patent Office. The ancient (1894) case of *Morgan v. Daniels* test is particularly inapplicable where new evidence is presented. To impose an almost conclusive presumption after a proceeding in which a litigant is denied the fundamental requirements of a fair hearing is a violation of the due process provisions of the Constitution of the United States, which read as follows:

"No person shall be . . . deprived of life, liberty, or property, without due process of law; nor shall private property be taken for public use, without just compensation."

The history of earthquakes throughout the United States and throughout the world was not considered by the Patent Office in determining the patent application here, fulfilling as it does an unsupplied need. The examiners here made no mention of the prior art as fulfilling this need, nor has the construction placed upon the prior art by municipalities been given the weight to which it is entitled. Of course, counsel could not bring these

facts out on examination or cross-examination of the Patent Office examiners as they were not called or put on the stand.

California has been peculiarly the victim of massive earthquakes. San Francisco was hit by a disastrous earthquake on the morning of April 8, 1906. Long Beach and its surrounding areas have also been hit with terrific earthquakes. Set out in the appendix hereto are some photographs of earthquakes in California, a U.S. Geological Survey Map with Master Fault Rifts of Southern California, a Geomorphic Map of California, and a summary of some of the world's major earthquakes. To protect against these conditions, the cities of California have adopted building codes with which to protect structures in this earthquake country.

As said by R.T. Hill in his book published by the Southern California Academy of Sciences, entitled *Southern California Geology and Los Angeles Earthquakes*, "Experiences of the past show that no moderately well constructed building has ever been destroyed by earthquakes in Southern California." It is to meet such a construction as required and approved by the cities that the Pollack and Adams patents have been devised and are being carried out commercially successful because of this situation. No prior art reaches these conditions.

In their excellent book *Geology Principles and Processes*, by William H. Emmons, George A. Thiel, Professor of Geology, University of Minnesota, Clinton R. Stauffer, Professor Emeritus of Geology, University of Minnesota and Research Associate, California Institute of Technology, and Ira S. Allison, Professor of Geology, Oregon State College, it is stated:

"Examinations of ruins of the San Francisco earthquake of 1906 showed that many of the bricks had been

laid dry in mortar. They were poorly bonded and had clean surfaces, and the mortar showed little adhesion. Walls laid in cement with wet brick stood the test of the earthquake better. Reinforced-concrete buildings have proved relatively stable, but wood, steel, and reinforced-masonry structures can be earthquake-resistant if well-designed and well-built, with the use of adequate reinforcements and appropriate ties, bracing, struts, and anchor bolts. The most secure structure is one that will move as a unit." (p. 558)

Pollack and Adams' aim was to meet this need for walls that would be earthquake resistant. Their wall is unique in that all materials work as a unit. The brick, steel, and concrete, in the right proportion and in the right scheme, reinforce each other. This becomes patentable. Their wall will "move as a unit" and when pushed, every element of the wall works in its best relationship to carry the load.

The work of Pollack and Adams meets the requirements which earthquakes, particularly the San Francisco earthquake, showed had not been met by other construction methods. They are therefore entitled to a patent for the development which cities throughout earthquake-State California have found meets their community standards.

On Columbus Day, October 12, 1965, Yale University published a map, stating that Leif Ericson had discovered America possibly 1000 years before Columbus. In commenting on this announcement, Eric Severeid, Columbia Broadcasting commentator, stated that Leif Ericson reportedly discovered America a thousand years before Columbus and did nothing about it. Columbus discovered America and opened up an entire new world.

We think the analogy may well apply to patents. The Patent Office says that there were three earlier patents,

the Hild patent, the Simms patent and the Betzler patent. But nobody did anything about it, at least nothing was done to apply them to earthquake country and the important needs in lands affected by severe earthquakes. Pollack and Adams discovered a way of building grouts highly useful and protective in earthquake country. Cities have adopted ordinances and regulations approving their method and requiring their type of construction in earthquake country. Surely the spark of genius which enabled them to comply with this great need should be protected by a patent and should not be obscured by alleged earlier references which did not fill the need and were not meant to reach this requirement.

Attention of the Court is also called to the fact that a similar question is raised by *Goodyear Tire and Rubber Co. et al. v. Commissioner of Patents*, No. 601, which is now pending before the Court.

We respectfully pray for certiorari and for an order overruling the Commissioner of Patents, and an order directing that the patents be issued to Sheldon L. Pollack and Max E. Adams as prayed for.

Respectfully submitted,

MORRIS LAVINE
Attorney for Petitioners



U.S. Geological Survey Map with Master Fault Rifts of Southern California



Geomorphic Map of California

EARTHQUAKES

Lisbon, 1755. On All Saints' Day, November 1, 1755, thousands of persons were congregated in the cathedrals of Lisbon, Portugal, when at 9:40 a.m. the city was struck by a violent earthquake, 6 or 7 minutes long, that virtually destroyed the churches and other buildings of the city and killed tens of thousands.

New Madrid, 1811-1812. A little after 2 a.m. on December 16, 1811, a major earthquake struck the region of New Madrid, Missouri. There followed 27 aftershocks before dawn and a declining series of shocks for days afterward. On January 23, 1813, a second great temblor struck, and on February 7, 1812, a third rocked the area the most severely of all. In 3 months' time a total of 1,874 shocks was noted at Louisville, Kentucky, 200 miles away. Chimneys were toppled in Cincinnati, Ohio, 400 miles away.

Charleston, 1886. On August 31, 1886, a violent earthquake shook the city of Charleston, South Carolina, for about 70 seconds. Buildings on filled-in ground were heavily damaged, roads and railroads were twisted about, air and water spurted out of the ground, and sand mounds were built up at many places. The earthquake was felt over most of the eastern part of the United States, from Boston to Milwaukee to New Orleans.

Assam, 1897. At about 5:15 p.m., June 12, 1897, an earthquake severely shook the region of the province of Assam in eastern India. Inasmuch as damage to buildings was almost total over an area of about 30,000 square miles and the acceleration was great enough to overcome gravity and project stones vertically off the ground, this earthquake may be the most severe one known, although only a moderate number of persons were killed.

California Earthquake. On April 18, 1906, California was shaken by the most severe earthquake in the history of the state. About 700 persons were killed, buildings were destroyed, and in a fire that followed the earthquake, a large part of San Francisco was burned. Piers in harbors nearby were destroyed, and landslides occurred. The first snap, or movement, of the earth was recorded at the observatory of the University of California and was found to be 3 inches in a horizontal and 1 inch in a vertical direction. Quickly following the first snap were rebounds over the greatly disturbed area on both sides of a fault line. These movements, or "temblors", brought down chimneys and towers. The shocks were felt from Coos Bay, Oregon, to Los Angeles and were recorded at Washington, D. C.; at Potsdam, Germany; Irkutsk, Siberia; and other places. The San Andreas fault that caused the California earthquake is approximately vertical, and the movement along it was approximately horizontal.

Sagami Bay. On September 1, 1923, a great earthquake destroyed Yokohama and a large part of Tokyo, Japan. At 11.58:44 a.m. a violent shock shook the houses and other structures.

Long Beach, California. At Long Beach, California, there was a shock March 10, 1933. At short distances away it was not a strong shock as recorded by seismographs, but it was severe locally, and since there is deep alluvium over much of the area, there was heavy damage and some loss of life. The point of origin was a little offshore. There was no sea wave and no notable disturbance of water, although vessels nearby felt the tremors.

Helena, Montana. Some earthquakes consist of a large number of small shocks. These are *swarm earthquakes.* At Helena, Montana, from October 18, 1935, to January

1, 1936, there were nearly 1,300 shocks; strong shocks on October 18, November 28, and December 31 were destructive. Forty houses were ruined, 200 considerably damaged, and 80 per cent of the houses in the city suffered some damage. In mines nearby the shock was felt strongly, but no damage was done to them.

Arvin-Tehachapi, California. The strongest California earthquake since 1906 struck the Arvin-Tehachapi area at the south end of the San Joaquin Valley, California, on July 21, 1952. It had a maximum intensity of XI, but only 14 lives were lost, as the area is thinly settled.

Orleansville, Algeria. About 1:07 a.m., September 9, 1954, a severe earthquake occurred at Orleansville, in northern Algeria, wrecking much of the city and killing more than a thousand of the 32,500 population. The earth fractured, and open fissures appeared for 60 miles around.

Other Earthquakes. References to earthquakes appear in ancient and medieval writings of Greece, Italy, and other countries, as well as in modern records. It has been estimated that in 10 great shocks since A.D. 1000 more than 1½ million persons have lost their lives and that in 4,000 years more than 13 million persons have been killed.

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IN THE

Supreme Court of the United States

October Term, 1965

No. 413

Sheldon L. Pollack and Max E. Adams,

Petitioners,

vs.

Commissioner of Patents,

Respondent.

PETITION FOR REHEARING

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IN THE

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PETITION FOR REHEARING

We respectfully petition for rehearing in the above matter on the following grounds, to-wit:

1. The Court, we believe, has overlooked important questions of constitutional and statutory law which should be decisive of this case, namely, the right to be heard fully and to examine and cross-examine witnesses on matters that decide important rights. Here, the right to a patent to protect inventors in earthquake country to be able to construct buildings protected against the ravages of nature (see photographs in our reply to opposition of government to petition for writ of certiorari) is involved. It is stated in *Powell v. Alabama*, 287 US 45, 77 L.ed. 158:

> "The words of Webster, so often quoted, that by 'the law of the land' is intended 'a law which hears before it condemns,' have been repeated in varying

forms of expression in a multitude of decisions." (77 L.ed. 170).

2. The Court still has before it *Goodyear Tire & Rubber Co., et al., v. Commissioner of Patents*, No. 601, which raises a similar question and the government, in answer to that case, also called attention to our case.

3. We would respectfully ask the members of the Court to re-examine again our reply to the opposition of the government to our petition for certiorari in this case, No. 413, showing the damage of earthquakes to buildings which the Pollack and Adams method of construction is designed to overcome.

This case raises an important constitutional question which we believe this Court has overlooked and to which we did not previously call its attention, namely, that the power to create presumption is not a means of escape from constitutional restrictions.

New York Times Co. v. Sullivan, 376 US 254, at 284, 11 L.ed.2d 686, 84 Sup.Ct. 710

And see:

Bailey v. Alabama, 219 US 219, 239, 55 L.ed. 191, 200

The constitutional restriction against presumptions forbids even Congress from nullifying the right of due process of law and the right to have witnesses come before the court in a trial for a proper examination and a proper cross-examination. What has happened in this patent case is that the courts below have ignored this constitutional restriction on the Patent Office, requiring that Office, in the case of a trial *de novo*, to present witnesses for examination and cross-examination. This important right has been upheld as an important right of due process of law guaranteed, in the case of States, by the

Fourteenth Amendment, and in the federal government by the Fifth Amendment.

In adopting Section 145 of Title 35, U.S. Codes, authorizing a trial *de novo*, Congress certainly meant that *all* the witnesses should be produced and that a trial should not rest on a "presumption of validity" attaching to the Patent Office's adjudications where the Patent Office examiners, who make the adjudications, are not subject to examination or cross-examination either as to their qualifications or their past experience and no facts are shown upon which they based their determination against petitioners. Such a proceeding surely is contrary to constitutional restrictions of due process of law — a law which hears and sees before it condemns — and it is evident that there was Congressional intent to require such evidence to be produced at a trial *de novo* when Congress revised Statute 4915 of the Revised Statutes, which did not contain the words "trial *de novo*". These words certainly have a well known legal meaning in our courts and mean an entire new trial and not a trial resting on a presumption. Where witnesses are produced contrary to the presumption, the presumption disappears. Otherwise, the presumption becomes, as here, conclusive and destroys even a "trial *de novo*".

In the instant case, the government produced no witnesses, did not present any evidence from the Patent Office, did not present its technicians for examination or cross-examination, a basic requirement of due process of law guaranteed by the Fifth and Fourteenth Amendments to the Constitution of the United States. Paraphrasing the language of *New York Times Co. v. Sullivan, supra,* in a case involving the First and Fourteenth Amendments, where the Alabama court presumed malice, this Court said:

"Such a presumption is inconsistent with the federal rule. 'The power to create presumptions is not a means of escape from a constitutional restriction; Bailey v. Alabama, 219 US 219, 239, 55 L.ed. 191, 200, 31 S.Ct. 145. The showing of malice required for the forfeiture of the privilege is not presumed but is a matter for proof by the plaintiff. ...." (376 US 284, 11 L.ed.2d 709)

Likewise, the showing of non-patentability, we believe, required for the forfeiture of the privilege of a patent is not presumed but is a matter for proof by the Patent Office. We respectfully submit that this Court has overlooked this important principle of constitutional law which applies equally to all departments of government.

The legal effect of a presumption has been universally held to be that it is dispelled when evidence is introduced which overcomes it and that presumption disappears.

Particularly in this case, the genius of invention of these inventors in connection with earthquake country has not been explored in any of the matters before the Patent Office. We think that very important principles are involved herein which have not been but should be reconsidered by the government. We think that the effect of this Court's decision in this case and in similar cases makes the Patent Office the judge, jury and executioner, too, as Gilbert and Sullivan have said in their famous play, The Mikado.

In Burrill and DeCamp's book on Inventions, Patents and Managements, page 521, it is stated:

"We have mentioned some reasons why the standard of patentability is not higher, such as the pressure of work on the examiners and the lack of adequate library facilities. The examiners' salaries are modest so that many leave the office to go into private practice just as they are becoming really expert."

We have no way of knowing whether the Patent Office in any way considered the proposed patent on the basis of its important utility, its importance in connection with earthquake country; there is no evidence that it did. We submit that we are entitled to have the case reheard on this basis.

We therefore respectfully petition for rehearing and reversal of the judgments and orders below.

Respectfully submitted,

MORRIS LAVINE

Attorney for Petitioners

CERTIFICATE OF COUNSEL

I, Morris Lavine, counsel of record, do hereby certify that the foregoing petition for rehearing is filed in good faith and not for the purpose of delay and that it involves consideration of a case now pending, but undecided, which was not pending at the time the original petition for certiorari was filed and also involves other matters not previously called to the attention of the Court.

MORRIS LAVINE